

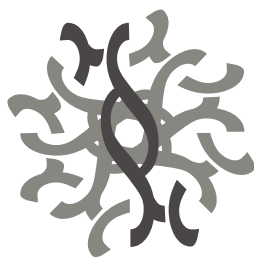


Newsletter Edition 8/2021

Düsseldorf/Essen/Frankfurt/Munich, 11 June 2021

Second Patent Law Modernization Act
passed - further amendment of §139

Two updates: New hearing date in G1/21 -
ECJ-FRAND referral lapses



M I C H A L S K I • H Ü T T E R M A N N
P A T E N T A N W Ä L T E

Second Patent Law Modernization Act passed - further amendment of §139

Yesterday, on June 10, 2021, the German Bundestag approved the second Patent Law Modernization Act with the coalition's votes. As it is not subject to approval, it can be assumed that it will enter into force in the near future. Compared to the government draft¹, essentially only one, albeit very important change was made concerning §139, the injunctive relief in patent law.

While the government draft was still to amend §139, para. 1 as follows:

"The claim is excluded insofar as the claim would lead to disproportionate hardship for the infringer or third parties not justified by the exclusive right due to the special circumstances of the individual case. In this case, the infringing party may demand compensation in money insofar as this appears appropriate. The claim for damages under paragraph 2 shall remain unaffected by this."

this was amended by the Legal Committee as follows and is thus future law:

"The claim is excluded insofar as the claim would lead to disproportionate hardship for the infringer or third parties not justified by the exclusive right due to the special circumstances of the individual case and the requirements of good faith. In this case, the infringing party shall be granted appropriate compensation in money. The claim for damages pursuant to paragraph 2 shall remain unaffected hereby."

So, as a result, two changes were made:

- In determining whether injunctive relief can be precluded, consideration should be given not only to the circumstances of the particular case, but also to "the requirements of good faith."
- The previously only optional monetary compensation now becomes mandatory.



EQE Preparatory Courses 2021

There are still places available on our preparatory courses for the C and D parts of the European Qualifying Examination (EQE). Provided the pandemic situation allows, the courses will take place on Monday/Tuesday, November 22/23, and Saturday/Sunday, December 4/5, 2021. Both courses are identical in content, so attendance at one course is sufficient.

The course content is mainly focused on appropriate exam techniques as well as strategies for avoiding mistakes in order to be able to successfully tackle the C and D parts of the EQE exam with these skills. It has been our experience that well-prepared exam materials significantly increase the chances of success. Therefore, we want to provide the participants with the necessary methodological knowledge in this course. In this respect, the course is to be understood as a supplement to the participants' own preparation of the legal fundamentals of the EPC. Instead, participants will learn how to convert their technical knowledge of the EPC into as many points as possible for passing the C and D parts of the EQE examination. The courses take place in Düsseldorf at our premises in Speditionstr. 21 and are free of charge. Speakers of the course are Dr. Torsten Exner, Dipl.-Ing. Andreas Gröschel and Dr. Aloys Hüttermann.

Registration is now possible (please state your full name and employer) at eqe@mhpatent.de.

¹ s. our newsletter [2/2020](#)

This means, as the corresponding [explanatory statement](#) also clearly points out, that the position of the patent proprietor has been improved compared to the government draft. On the other hand, the suggestion of² the German Bundesrat to introduce an expiry period instead of the permanent refusal of injunction relief according to the wording of the “Wärmetauscher” (“Heat Exchanger”) decision was not followed. In a statement³ on this suggestion, the government had replied that corresponding considerations had been made when planning the law, but that the version presented was considered to be the most suitable.

Otherwise, only formal changes have been made to the government draft. The previous regulations, the most important of which are summarized below, therefore remain⁴ unchanged:

- Invalidity proceedings are to be streamlined by setting the defendant (= patent proprietor) a time limit for a substantive reply, as well as by providing the qualified notice six months after service of the action.
- However, a reform of the nullity proceedings in such a way that the prohibition on filing nullity suits when opposition is still possible or opposition proceedings are still ongoing would be at least partly lifted was refrained from. This was still envisaged in the Ministry of Justice’s draft, but had already been deleted in the government’s draft. However, the relevant consultations and discussions are to be continued, so that this may still come at a later date.
- The PCT nationalization period for Germany is extended to 31 months. The proposals for the introduction of a “German Rule 161/162” or the possibility of also submitting a German translation at a later date, on the other hand, were rejected.
- The secrecy options under the Trade Secret Protection Act (Geheimnisschutzgesetz) now also apply analogously in patent infringement proceedings.

The law provides for certain parts to enter into force only after nine months after promulgation, and not, as is otherwise customary, on the day after promulgation. This particularly affects the new version of §83 (qualified notice after six months), but not §139.

Whether and how the courts will make use of the possibility to deny injunctive relief remains to be seen - however, it can probably be predicted that until a solid case law practice has been established, such a request will probably be filed by the defendant in almost every patent infringement case.



² s. our newsletter [1/2021](#)

³ s. <https://dserver.bundestag.de/btd/19/258/1925821.pdf> (p. 76ff)

⁴ s. our newsletter [2/2020](#)

Two updates: New hearing date in G1/21 - ECJ-FRAND referral lapses

Two updates concerning topics of previous newsletters are briefly reported.

Firstly, after the first hearing in G1/21 was adjourned⁵, the Grand Board of Appeal has [scheduled a](#) new hearing for July 2. This had been expected by us before approximately.

It has also⁶ been reported that Daimler and Nokia have reached an agreement on a license, which means that all mutual disputes have been settled. This in turn means that the referral to the ECJ⁷ regarding further details of FRAND licensing is also no longer valid and the ECJ will therefore not make a decision on the questions raised for the time being. In view of the importance of the questions submitted, however, it cannot be ruled out that in an analogous case in the future a court will make a renewed submission.

In our own affairs

We wish your relatives, employees, colleagues and of course yourself all the best for the current, still difficult time.

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⁵ s. our newsletter [7/2021](#)

⁶ s. <https://www.juve-patent.com/news-and-stories/cases/nokia-and-daimler-settle-all-global-litigation-in-connected-cars-dispute/>

⁷ s. our newsletter [12/2020](#)